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Intellectual Property Causes  
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MAY 23 2003

**TC 1700**Attorney Docket No. P20740

In re application of : Helmut JAKUSCH et al.

Mail Stop Non-fee

Serial No. : 09/826,901

Group Art Unit: 1773

Filed : April 6, 2001

Examiner: Sheeba Ahmed

For : MAGNETIC RECORDING MEDIUM

**Mail Stop Non-Fee**

COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

☐ A Request for Extension of Time.

☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims:21	*21	0	x 9=	\$	x 18=	\$0.00
Indep. Claims:5	**5	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

\*If less than 20, write 20

\*\*If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$\_\_\_\_\_.

N/A A Check in the amount of \$\_\_\_\_\_ to cover the filing/extension fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136) (a)(3)

Neil F. Greenblum

Reg. No. 28,394

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**TC 1700**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Helmut JAKUSCH et al.

Group Art Unit : 1773

Serial No : 09/826,901

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Filed : April 6, 2001

For : MAGNETIC RECORDING MEDIUM

**ELECTION WITH TRAVERSE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the requirement for restriction under 35 U.S.C. 121 mailed from the U.S. Patent and Trademark Office on April 22, 2003, which sets a one month shortened statutory period for response until May 22, 2003.

Applicants note that this response is being submitted by the initial due date of May 22, 2003, whereby an extension of time and an extension of time fee are not required for maintaining the pendency of the application. However, if any government fees are required for maintaining the pendency of this application, including any extension of time fees, this response expressly requests and authorizes that any such required fee be charged to Deposit Account No. 19-0089.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks which follow:

**Restriction Requirement**

The Examiner has required restriction to one of the following inventions under 35 U.S.C. 121:

I. Claims 1-16, 18, 19, and 21 are drawn to a magnetic recording medium, classified in class 428, subclass 336+.

II. Claims 17 and 20, drawn to a process for making a magnetic recording medium, classified in class 427, subclass 457+.

**Election**

In order to be responsive to the requirement for restriction, Applicants elect the invention set forth in Group I, claims 1-16, 18, 19 and 21, with traverse.

**Traverse**

Notwithstanding the election of the claims of Group I in order to be responsive to the Restriction Requirement, Applicants respectfully traverse the Examiner's requirement for restriction.

Initially, it is noted that the requirement for restriction omits one of the two criteria of a proper requirement as now established by U.S. Patent and Trademark Office policy, as set forth in MPEP 803, viz. that "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if a restriction were not required. Due to the aforementioned

omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested.

Related to this, the requirement is traversed since there would not appear to be a serious burden to examine Applicants' application in total, and for which the appropriate claim fees have been paid. Applicants submit that it would be no serious burden on the Examiner to examine all of the pending claims, because a search for all of the claims in the above-identified application, should be made in order to do a complete and thorough search in view of the recognized relationship between the claims in Groups I and II, as stated in the Office Action.

Furthermore, as the Examiner appreciates, in order to justify a requirement for restriction the difference between the invention defined by the various groups of claims must be material. However, the differences pointed out in the requirement do not appear to be material for examination purposes.

It is noted that the claims of Group I are directed, as recited in independent claim 1, to a multilayer magnetic recording medium which comprises, on a nonmagnetic substrate, at least one upper binder-containing magnetic recording layer which has a thickness of less than  $0.5\ \mu\text{m}$  and contains finely divided magnetic pigment having a coercive force  $H_c$  of 100 - 250 kA/m, and at least one lower binder-containing layer which contains an isotropic magnetically soft pigment which is selected from  $\gamma\text{-Fe}_2\text{O}_3$ ,  $\text{Fe}_3\text{O}_4$  or a solid solution of these components and has a mean crystalline size of less than  $10\ \mu\text{m}$ . Similarly, Group II as recited in independent claim 17 is directed to a process for the production of a multilayer magnetic recording medium which comprises, on a nonmagnetic substrate, at least one upper binder-containing magnetic recording

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layer which has a thickness of less than  $0.5\ \mu\text{m}$  and contains finely divided magnetic pigment having a coercive force  $H_c$  of 100 - 250 kA/m, and at least one lower binder-containing layer which contains an isotropic magnetically soft pigment which is selected from  $\gamma\text{-Fe}_2\text{O}_3$ ,  $\text{Fe}_3\text{O}_4$  or a solid solution of these components and has a mean crystalline size of less than  $10\ \mu\text{m}$ .

Accordingly, there should not be an undue burden to examine both Groups of claims for this reason as well as for similarities between other claims in the two groups of claims.

In any event, even if the restriction is maintained, upon allowance of the claims of Group I, the non-elected claims of Group II should be rejoined and allowed with the elected claims.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

#### CONCLUSION

For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper and should be withdrawn.

Withdrawal of the requirement for the restriction with the examination of all claims pending in this application is respectfully requested.

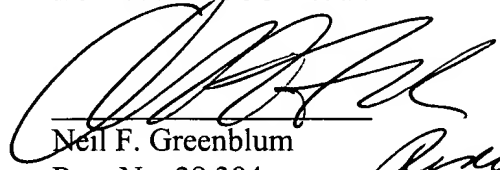
Favorable consideration with early allowance of the pending claims is most earnestly requested.

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If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

May 22, 2003  
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Respectfully submitted,  
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